

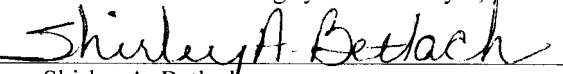
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant:	Luc R. Mongeon, Jesus Casas-Bejar, H. Toby Markowitz, Daisy P. Cross, Janelle Blum, Michael Ebert and Timothy G. Laske	Confirmation No.	2842
Serial No.:	10/663,570	Group Art Unit:	3762
Filed:	September 15, 2003	Customer No.:	28863
Examiner:	Michael William Kahelin		
Docket No.:	1023-203US01		
Title:	DELIVERING GENETIC MATERIAL TO A STIMULATION SITE		

CERTIFICATE UNDER 37 CFR 1.8 I hereby certify that this correspondence is being transmitted via the United States Patent and Trademark Office electronic filing system on May 8, 2009.

By:



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APPEAL BRIEF

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Sir:

This is an Appeal Brief in support of an appeal from the final Office Action dated January 23, 2009 finally rejecting claims 21–24, 26, 29–33, 35–42, and 46. The Notice of Appeal was filed on March 23, 2009. The period for filing this Brief runs through May 23, 2009.

Please charge Deposit Account No. 50-1778 the amount of \$540.00 for submission of this Appeal Brief, as required by 37 C.F.R. §41.37(a)(2) for a large entity. Please charge any additional fees that may be required or credit any overpayment to Deposit Account No. 50-1778.

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REAL PARTY OF INTEREST

The Real Party of Interest is Medtronic, Inc. of Minneapolis, Minnesota.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences for the above-referenced patent application.

STATUS OF CLAIMS

Claims 21–24, 26, 29–33, 35–42, and 46 are pending and are the subject of this appeal. Claims 21–24, 26, 29–33, 35–42, and 46 are set forth in Appendix A. Originally filed claims 5–8 were canceled in an Amendment filed on August 4, 2006. In addition, originally filed claims 11 and 27 were canceled in an Amendment filed on June 28, 2007, and originally filed claims 20, 25, 28, and 34 were canceled in an Amendment filed on October 29, 2007. Claims 40–45 were added by way of an Amendment filed on August 4, 2006. Claim 46 was added by way of an Amendment filed on November 7, 2008. Claims 1–4, 9, 10, 12–19, and 43–45 were canceled in an Amendment filed on November 7, 2008 as being drawn to a nonelected invention.

Claims 21–24, 26, 29–33, 35–42, and 46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Soykan et al. (U.S. Patent No. 6,151,525, hereinafter “Soykan”) in view of Heil, Jr. et al. (U.S. Patent No. 4,819,662, hereinafter “Heil”) and Girouard et al. (U.S. Patent Application Publication No. 2004/0158289, hereinafter “Girouard”).

STATUS OF AMENDMENTS

The claims on appeal are those submitted in the Amendment filed on November 7, 2008. The final Office Action dated January 23, 2009 indicates that the Examiner entered the Amendment filed on November 7, 2008. No amendments were submitted after the final Office Action dated January 23, 2009.

SUMMARY OF CLAIMED SUBJECT MATTER

In general, Appellant's disclosure relates to delivering genetic material to tissue at a stimulation site to increase conductivity of the tissue.¹

Independent claim 1 is directed to a medical lead² including a lead body,³ a porous electrode⁴ mounted on the lead body to deliver electrical stimulation⁵ to a stimulation site⁶ within a patient, and a chamber body⁷ that defines a chamber. The chamber contains a polymeric matrix⁸ that absorbs⁹ a genetic material¹⁰ and elutes¹¹ the genetic material to tissue at the stimulation site via the porous electrode, wherein the genetic material is adapted to cause expression of at least one of a connexin¹² or a gap-junction¹³ by the tissue at the stimulation site to increase the conductivity of the tissue at the stimulation site.¹⁴

Independent claim 35 is directed to a method comprising introducing genetic material to a polymeric matrix,¹⁵ and placing the matrix into a chamber formed by a chamber body¹⁶ of a medical lead¹⁷ for elution of the genetic material to tissue of a patient at a stimulation site.¹⁸ The genetic material is adapted to cause expression of at least one of a connexin¹⁹ or a gap-junction²⁰ by the tissue at the stimulation site to increase the conductivity of the tissue at the stimulation site.²¹ According to claim 35, the medical lead includes a porous electrode,²² and the matrix elutes the genetic material to the stimulation site via the porous electrode.²³

¹ Appellant's disclosure at p. 2, ll. 6–11.

² *Id.* at p. 4, ll. 15 and 16, and lead 18 shown in FIG. 1 and lead 50 shown in FIGS. 3A and 3B.

³ *Id.* at p. 5, ll. 18–20, and lead body 36 shown in FIG. 2 and lead body 52 shown in FIGS. 3A and 3B.

⁴ *Id.* at p. 7, ll. 1–5, and electrode 54 shown in FIGS. 3A and 3B.

⁵ *Id.* at p. 8, ll. 23–25.

⁶ *Id.* at p. 8, ll. 23–25, and stimulation site 12 shown in FIGS. 1 and 2.

⁷ *Id.* at p. 6, ll. 1 and 2, and chamber body 56 shown in FIGS. 3A and 3B.

⁸ *Id.* at p. 6, ll. 12–16, and matrix 58 shown in FIG. 3A.

⁹ *Id.* at p. 6, ll. 13 and 14.

¹⁰ *Id.* at p. 6, ll. 12 and 13.

¹¹ *Id.* at p. 6, ll. 14 and 15.

¹² *Id.* at p. 4, ll. 23–26.

¹³ *Id.*

¹⁴ *Id.*

¹⁵ *Id.* at p. 7, ll. 6–11, and block 70 shown in FIG. 4.

¹⁶ *Id.* at p. 7, ll. 12–14.

¹⁷ *Id.* at p. 4, ll. 15 and 16, and lead 18 shown in FIG. 1 and lead 50 shown in FIGS. 3A and 3B.

¹⁸ *Id.* at p. 6, ll. 13–15.

¹⁹ *Id.* at p. 4, ll. 23–26.

²⁰ *Id.*

²¹ *Id.*

²² *Id.* at p. 7, ll. 1–5, and electrode 54 shown in FIGS. 3A and 3B.

²³ *Id.* at p. 6, ll. 13–15.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Appellant submits the following ground of rejection to be reviewed on appeal: the rejection of claims 21–24, 26, 29–33, 35–42, and 46 under 35 U.S.C. § 103(a) as being obvious over Soykan in view of Heil and Girouard.

ARGUMENT

Appellant respectfully requests reversal of the rejection of claims 21–24, 26, 29–33, 35–42, and 46 by the Board of Patent Appeals based on the arguments below. For the ground of rejection to be reviewed on appeal, Appellant respectfully requests separate review of each set of claims argued under separate headings. For at least the reasons presented below, the Examiner has failed to establish a *prima facie* case of obviousness with respect to Appellant's claims 21–24, 26, 29–33, 35–42, and 46.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL - THE REJECTION OF CLAIMS 21–24, 26, 29–33, 35–42, and 46 UNDER 35 U.S.C. § 103(a)

Claims 21–24, 26, 29–33, 35–42, and 46 stand rejected under 35 U.S.C. § 103(a) as being obvious over Soykan in view of Heil and Girouard. For at least the reasons discussed below, the rejection of claims 21–24, 26, 29–33, 35–42, and 46 as being obvious over Soykan in view of Heil and Girouard should be reversed.

CLAIMS 21–24, 26, AND 29–33

Soykan in view of Heil and Girouard lacks any teaching that would have suggested a medical lead that includes a porous electrode and a chamber body that defines a chamber containing a polymeric matrix that absorbs a genetic material and elutes the genetic material via the porous electrode to tissue at the stimulation site, where the genetic material is adapted to cause expression of at least one of a connexin or a gap-junction by the tissue at the stimulation site to increase the conductivity of the tissue at the stimulation site, as recited by independent claim 21.

In support of the rejection of independent claim 21 as being obvious over Soykan in view of Heil and Girouard, the Examiner stated that Soykan discloses a lead that delivers electrical

stimulation to a tissue site and elutes genetic material from a polymeric matrix.²⁴ The Examiner acknowledged that Soykan does not disclose or suggest required elements of Appellant's claimed lead, such as a chamber that elutes material from a porous electrode or a genetic material that is adapted to cause expression of at least one of connexin or a gap junction.²⁵ The Examiner looked to both Heil and Girouard to cure the identified deficiencies in the Soykan reference. In particular, the Examiner asserted that Heil discloses "a lead with a removable chamber that elutes substances through a porous electrode" and Girouard discloses "providing a cardiac therapy comprising delivering connexin."²⁶

The Examiner reasoned that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Soykan in view of Heil and Girouard "for the purpose of providing controlled release of pharmacological agents at the site of electrical therapy and providing a cardiac therapy comprising delivering connexin for the purpose of repairing damaged heart tissue."²⁷ The Examiner's conclusion of obviousness is erroneous. The medical lead of independent claim 21 is not obvious over Soykan in view of Heil and Girouard.

In order to support a rejection under 35 U.S.C. § 103(a), the Examiner must clearly articulate the reasons why the claimed invention would have been obvious.²⁸ In the present rejection of independent claim 21, the Examiner has failed to establish a rational reason for modifying Soykan in view of Heil and Girouard, and, thus, failed to establish a *prima facie* case of obviousness of claim 21. While the Examiner stated that one having ordinary skill in the art would have looked to Heil to modify Soykan in order to provide "controlled release of pharmacological agents at the site of electrical therapy,"²⁹ this purported reason lacks a rational underpinning.³⁰ This statement appears to overlook the fact that the system disclosed by Soykan already provides controlled release of a genetic material at the site of electrical therapy. For example, Soykan discloses coating or otherwise incorporating a genetic material into a carrier, which may be an electrical stimulation device.³¹ Soykan discloses that the genetic material may

²⁴ Final Office Action dated January 23, 2009 at p. 2, item 4.

²⁵ *Id.* at p. 3, item 4.

²⁶ *Id.*

²⁷ *Id.* at pp. 3 and 4, item 4.

²⁸ See *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) and MPEP 2141(III).

²⁹ Final Office Action dated January 23, 2009 at pp. 3 and 4, item 4.

³⁰ See MPEP 2142, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) ("[R]ejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.")

³¹ Soykan at col. 11, ll. 5-7.

be delivered in a polymeric matrix.³² According to the Examiner, “[t]he level of cross-linking [of a matrix] is inherently proportional to the release rate.”³³

Heil does not provide any indication that the porous electrode is advantageous over the coating disclosed by Soykan for releasing a genetic material, or provides some expected beneficial result over the coating disclosed by Soykan. Accordingly, the cited art does not support the Examiner’s proposed reason that one having ordinary skill in the art would have had modified Soykan in view of Heil. Indeed, absent access to Appellant’s disclosure, there is no rational reason why one having ordinary skill in the art would have looked to Heil, which relates to a drug eluting lead, to modify Soykan, which relates to a device that releases a genetic material, in the manner suggested by the Examiner.

According to the Examiner, a rational reason need not be shown for modifying Soykan with Heil because “modifying Soykan’s genetic material-eluting cardiac device with Heil’s known prior art drug-eluting cardiac device is a simple substitution of one known element for another to obtain the predictable results of controlled release of a therapeutic agent.”³⁴ However, even in the case of a claim rejection based on the “predictable results” rationale, identification of a reason why a person of ordinary skill would have combined the elements in the manner proposed by the Examiner is important.³⁵ The Examiner has failed to identify a rational reason why a person of ordinary skill would have combined the Soykan system and the Heil electrode. Therefore, the Examiner failed to establish a *prima facie* case of obviousness with respect to independent claim 21.

The modification of the Soykan system to include the porous electrode and recess (for retaining a matrix including a therapeutic drug) disclosed by Heil is not merely a simple substitution of one known element for another, nor does the modification proposed by the Examiner necessarily provide a “predictable result” of “controlled release of a therapeutic agent,” as asserted by the Examiner.³⁶ A drug, as disclosed by Heil, and a genetic material, as disclosed by Soykan, may have different purposes and different properties. As a result, there may be different considerations and objectives for elution of a drug versus elution of a genetic material. As an example of the differences between a drug and a genetic material, Appellant has

³² *Id.* at col. 11, ll. 15–16.

³³ Final Office Action dated January 23, 2009 at p. 4, item 6.

³⁴ *Id.* at p. 6, item 12 (Response to Arguments section).

³⁵ MPEP 2143, *citing KSR Int’l Co.*, 550 U.S. at 418.

³⁶ Final Office Action dated January 23, 2009 at p. 6, item 12 (Response to Arguments section).

recognized that expression of at least one of connexin or a gap-junction may provide advantages over elution of a drug, such as a desired effect that lasts longer and is more localized than that of drug.³⁷

In the final Office Action, the Examiner agreed that drugs and genetic materials are different, but asserted that the differences relate to different therapeutic effect and “do not pertain to the mechanical diffusion of these substances from a porous electrode.”³⁸ The Examiner asserted that because the electrode disclosed by Heil “is porous enough to allow for ‘free fluid flow,’” the electrode “is capable of eluting both drugs and genetic material.”³⁹ Appellant disagrees that different therapeutic effects of drugs and genetic materials are irrelevant to the diffusion of the materials from a porous electrode. The different therapeutic effects are necessarily considered when determining how the drug or genetic material should be eluted. As indicated above, Appellant has recognized that expression of at least one of connexin or a gap-junction may have a desired effect that lasts longer and is more localized than that of drug.⁴⁰ Thus, the desirable diffusion rates for providing the desired effect may differ between a drug and a genetic material. The references relied on by the Examiner fail to provide any indication that the “free fluid flow”⁴¹ provided by the Heil porous electrode is sufficient or even useful for the elution of a genetic material at a desirable rate for the particular application disclosed by Soykan.

References may only be modified to reject claims as *prima facie* obvious as long as there is a reasonable expectation of success.⁴² Neither the Heil nor Soykan disclosures provide reasonable support for asserting that modifying Soykan in view of Heil to include a matrix that elutes a genetic material to tissue at a stimulation site via a porous electrode would reasonably be expected to be successful. For example, the cited art fails to provide a reasonable basis for concluding that that elution of a genetic material via a porous electrode that also delivers electrical stimulation to tissue would be successful in causing expression of at least one of a connexin or a gap-junction by the tissue at the stimulation site. Heil only discusses a matrix that elutes a drug, and does not contemplate elution of a genetic material, much less elution of a genetic material that increases the conductivity of tissue at the stimulation site. Thus, there is no

³⁷ Appellant’s originally-filed disclosure at p. 2, ll. 6–13.

³⁸ Final Office Action dated January 23, 2009 at p. 5, item 11 (Response to Arguments section).

³⁹ *Id.*

⁴⁰ Appellant’s originally-filed disclosure at p. 2, ll. 6–13.

⁴¹ Heil at col. 2, ll. 38–41.

⁴² MPEP 2143.02 (I).

basis for asserting that it would have been obvious to one having ordinary skill in the art to modify the Soykan system to elute a genetic material via the porous electrode disclosed by Heil.

The Examiner also failed to provide any articulated reasoning for why one having ordinary skill in the art would have looked to Girouard to modify Soykan. The Examiner stated that one having ordinary skill in the art would have looked to Girouard to modify Soykan in order to provide “a cardiac therapy comprising delivering connexin for the purpose of repairing damaged heart tissue.”⁴³ This rationale, however, is circular and lacks a rational underpinning. The rationale provided by the Examiner fails to identify a reason that would have even prompted a person having ordinary skill in the art to even modify the type of genetic material disclosed by Soykan. Girouard does not provide any indication that connexin is advantageous over the genetic material disclosed by Soykan, or provides some expected beneficial result over the coating disclosed by Soykan.

According to the Examiner, “modifying Soykan’s cardiac-repairing genetic material with Girouard’s known prior art cardiac-repairing genetic material is a simple substitution of one known element for another to obtain the predictable results of repairing damaged heart tissue.”⁴⁴ This assertion is erroneous. As described in further detail below, Girouard proposes the use of a genetic material for a different purpose than Soykan. Thus, modifying the Soykan system to elute a genetic material that causes expression of connexin by tissue would have required more than a simple substitution of one known element for another.

The Examiner asserted that modifying Soykan in view of a genetic material disclosed by Girouard involves a simple substitution because both Soykan and Girouard disclose the use of a “cardiac-repairing genetic material.” However, Soykan is not merely directed at repairing damaged heart tissue. Instead, Soykan discloses the use of genetic material to convert noncontracting cells to contracting cells in an infarct zone of a patient’s myocardium, i.e., *in vivo*.⁴⁵ On the other hand, Girouard discloses a transgene that encodes, e.g., connexin-40, connexin-42, and connexin-43, to condition donor cells in vitro, prior to administration of the donor cells into a region of injured tissue of the patient.⁴⁶ In particular, Girouard uses the genetic material to subject donor cells to exogenous agents, such as differentiation factors, growth

⁴³ Final Office Action dated January 23, 2009 at p. 3, item 4.

⁴⁴ *Id.* at p. 6, item 13 (Response to Arguments section).

⁴⁵ Soykan at col. 7, ll. 54–60.

⁴⁶ Girouard at ¶¶ [0076], [0129], and [0146].

factors, and the like.⁴⁷ The donor cells are conditioned outside of the patient, and then subsequently introduced into the tissue region to be treated. Thus, while Girouard discloses providing cell therapy of living tissue, Girouard is only directed to the use of exogenous cells,⁴⁸ which may be conditioned using genetic material. The use of genetic material to condition exogenous cells by Girouard is contrary to Soykan, which discloses the conversion of cells in an infarct zone within the patient using genetic material.

Neither Soykan nor Girouard provides any indication that expression of connexin, which takes place ex vivo in the Girouard reference, may be simply substituted in the in vivo technique disclosed by Soykan, as asserted by the Examiner.⁴⁹ Moreover, Girouard does not even contemplate delivering a genetic material that causes expression of connexin to an infarct zone of a heart of a patient to convert noncontracting cells (e.g., fibroblasts) to contracting cells (e.g., myoblasts) *in vivo* to reverse damage to necrotic heart muscle,⁵⁰ as required by Soykan. Instead, Girouard merely contemplates the use of connexin to condition exogenous cells *in vitro*. According to Girouard, exogenous cells are subsequently introduced into other cells.⁵¹ Therefore, exogenous cells are different than the noncontractile cells in an infarct zone, as disclosed by Soykan. For at least these reasons, the Examiner's assertion that the modification of Soykan in view of Girouard is obvious on the basis that it involves a simple substitution of one known element for another is erroneous.

It would not have been obvious to one having ordinary skill in the art at the time the invention was made to modify Soykan in view of either Heil or Girouard to arrive at the lead of Appellant's independent claim 21. According to the MPEP, a "combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results."⁵² Thus, in order to rely on the "predictable result" rationale to support the rejection of Appellant's independent claim 21, the proposed combination must combine the "elements" of the cited art according to known methods. Moreover, according to MPEP 2141, when considering obviousness of a combination of elements of cited references, the operative question

⁴⁷ *Id.* at ¶ [0146].

⁴⁸ *Id.* at Abstract.

⁴⁹ Final Office Action dated January 23, 2009 at p. 6, item 13 (Response to Arguments section).

⁵⁰ Soykan at col. 4, ll. 33–35 and ll. 49–56.

⁵¹ Girouard at ¶ [0056].

⁵² MPEP 2141, *citing KSR Int'l Co.*, 550 U.S. at 416.

is “whether the improvement is more than the predictable use of prior art elements according to their established functions.”⁵³

As established above, the combination of Soykan, Heil, and Girouard proposed by the Examiner changes the established functions of the cited references. Accordingly, Appellant’s claim 21 is not obvious in view of the cited references. Soykan discloses an implantable system that converts fibroblasts to myoblasts *in vivo* by delivering specific genetic materials, which Soykan fails to disclose or suggest cause expression of at least one of a connexin or a gap-junction, as required by claim 21.⁵⁴ The Examiner asserted that it would have been obvious to substitute a genetic material (causing expression of connexin) disclosed by Girouard in the Soykan system. However, Girouard does not use the genetic material *in vivo* for the same function as the Soykan genetic material. Instead, Girouard uses the genetic material that causes expression of connexin to condition exogenous cells *in vitro*, prior to introduction in the patient. Thus, the Examiner’s proposed use of connexin changes the function of connexin established by Girouard.

The asserted combination of elements of the references cited by the Examiner in support of the rejection of independent claim 21 is more than a mere predictable use of the elements according to the established functions. Indeed, modifying the Soykan system in view of Girouard to include a genetic material that causes expression of a connexin requires a change to the Girouard system, thereby rendering the combination nonobvious. The cited art fails to provide any indication that a genetic material that causes expression of a connexin (as disclosed by Girouard) is suitable for use *in vivo* to convert noncontractile cells to contractile cells, as required by Soykan. The *in vitro* use of the genetic material that causes expression of a connexin disclosed by Girouard differs from the *in vivo* technique disclosed by Soykan. For at least these reasons, even if Soykan, Heil, and Girouard disclose each and every element of the lead of Appellant’s claim 21, an assertion with which Appellant does not agree, Appellant’s claimed lead is more than just the predictable use of the elements of the cited references.

Appellant has recognized that delivering a genetic material that causes expression of a connexin or a gap-junction by tissue at a stimulation site increases the conductivity of the tissue

⁵³ MPEP 2141, *citing KSR Int’l Co.*, 550 U.S. at 417.

⁵⁴ Soykan at col. 7, ll. 53–60 and col. 8, ll. 1–5.

at the stimulation site, thereby forming a virtual biological electrode.⁵⁵ By delivering the genetic material via a porous electrode of a lead, the virtual biological electrode is in contact with the electrode of the lead. The delivery of pacing pulses by the electrode of the lead is facilitated by the virtual biological electrode at the stimulation site, which may, e.g., result in the capture of a heart of the patient at lower pacing pulse amplitudes.⁵⁶ In general, Appellant has recognized that the expression of connexin or a gap-junction by tissue at a stimulation site improves the characteristics of the electrode-tissue interface, which may help reduce the intensity of stimulation signals that are necessary to achieve a desired effect.⁵⁷ Reduction of the stimulation intensity is useful for prolonging the life of the battery of a medical device that delivers the stimulation therapy. The lead of claim 21 facilitates the delivery of the genetic material to achieve such benefits. The cited references fail to disclose or suggest the lead of claim 21.

Based on the lack of disclosure within Soykan, Heil, and Girouard regarding the possibility of eluting a genetic material that causes expression of a connexin or a gap-junction via a porous electrode, Soykan in view of Heil and Girouard fails to render Appellant's independent claim 21 obvious. In the present application, the gap between the cited art and the lead of Appellant's claim 21 is so great as to render independent claim 21 nonobvious to one having ordinary skill in the art.⁵⁸

For at least these reasons, the Examiner has failed to establish a *prima facie* case for non-patentability of Appellant's independent claim 21 under 35 U.S.C. § 103(a). Claims 22–24, 26, and 29–33 depend from claim 21 and are patentable over Soykan in view of Heil and Girouard for at least the reasons discussed above with respect to independent claims 21.

⁵⁵ Appellant's disclosure at p. 4, ll. 20–29.

⁵⁶ *Id.* at p. 4, ll. 27–31.

⁵⁷ Appellant's disclosure at p. 2, ll. 6–10.

⁵⁸ See MPEP 2141, citing *Dann v. Johnston*, 425 U.S. 219, 230 (1976).

CLAIM 46

Claim 46 specifies that the lead of independent claim 21 includes a chamber body defining a chamber that contains a polymeric matrix that absorbs a genetic material and elutes the genetic material to tissue at a stimulation site within a patient via a porous electrode, where the genetic material is adapted to cause expression of at least one of a connexin or a gap-junction by the tissue at the stimulation site to increase the conductivity of the tissue at the stimulation site and create a preferential conduction pathway between the stimulation site and at least one of a bundle of His or a Purkinje fiber of a heart of the patient. The cited art fails to disclose or suggest the lead of claim 46.

In support of the rejection of claim 46, the Examiner stated that claim 46 is directed to an inherent feature of Soykan and reasoned that “[b]ecause Soykan is in effect creating new contractile tissue around the stimulation device, this inherently creates a new arbitrary ‘preferred conduction pathway.’”⁵⁹ The Examiner is relying on an improper finding of an inherent disclosure in Soykan to support the rejection of claim 46. The creation of “new contractile tissue” around a stimulation device does not in any way suggest that the “new contractile tissue” defines a pathway that is more conductive than another.

The fact that a certain characteristic may be present in the prior art is not sufficient to establish the inherency of that result or characteristic.⁶⁰ The Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.⁶¹ No reasonable support has been provided for the determination that the conversion of noncontractile tissue to contractile tissue in an infarct zone, as disclosed by Soykan, necessarily creates a preferential conduction pathway between the stimulation site and at least one of a bundle of His or a Purkinje fiber of a heart of the patient. Rather, the formation of a conduction pathway that is the same as or less preferred to another pathway between a stimulation site and at least one of a bundle of His or a Purkinje fiber of the heart are just as likely in view of the lack of description provided by the Soykan reference. Accordingly, Appellant submits that the allegedly inherent characteristic does not necessarily flow from the teachings of Soykan, and that the Examiner has relied on an improper finding of inherent disclosure in Soykan to reject independent claim 46.

⁵⁹ Final Office Action dated January 23, 2009 at p. 7, item 15 (Response to Arguments section).

⁶⁰ *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993); MPEP § 2112.

⁶¹ *Ex parte Levy*, 17 USPQ.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original); MPEP 2112.

While Soykan discloses converting noncontractile cells to contractile cells with nucleic acid,⁶² Soykan does disclose or even suggest that such conversion to contractile cells necessarily results in the creation of a preferential conduction pathway between at least one of a bundle of His or a Purkinje fiber of a heart of the patient. A preferential conduction pathway clearly requires a pathway that is more preferred over another pathway. The conversion of noncontractile cells to contractile cells may improve the conduction pathway compared to the pathway that existed prior to the conversion of the cells to contractile cells. However, this improvement in the conduction pathway does not necessarily result in a pathway that is more preferred over other pathways between the stimulation site and the bundle of His or a Purkinje fiber of a heart of the patient.

Appellant's claim 46 recognizes that delivering a genetic material that causes expression of at least one of a connexin or a gap-junction by the tissue at the stimulation site to increase the conductivity of the tissue at the stimulation site can form a preferential conduction pathway to the bundle of His or a Purkinje fiber by increasing the conductivity of the tissue relative to other tissue.⁶³ Soykan does not inherently disclose that the conversion of noncontractile cells to contractile cells necessarily results in the creation of such a preferential conduction pathway.

For at least these reasons, the Examiner has failed to establish a *prima facie* case for non-patentability of Appellant's claim 46 under 35 U.S.C. § 103(a), and the rejection of claim 46 should be reversed.

CLAIMS 35–42

Independent claim 35 is directed to a method that comprises introducing genetic material to a polymeric matrix and placing the matrix into a chamber formed by a chamber body of a medical lead for elution of genetic material to tissue of a patient at a stimulation site, where the genetic material is adapted to cause expression of at least one of a connexin or a gap-junction by the tissue at the stimulation site to increase the conductivity of the tissue at the stimulation site, and where the matrix elutes the genetic material to the stimulation site via a porous electrode of the medical lead. Claim 35 was rejected under 35 U.S.C. § 103(a) as being obvious over Soykan in view of Heil and Girouard.

⁶² Soykan at col. 7, ll. 53–60.

⁶³ See Appellant's disclosure at p. 6, ll. 8–12.

As discussed above with respect to independent claim 21, Soykan in view of Heil and Girouard fails to disclose or suggest a medical lead that includes a matrix with a genetic material that is adapted to cause expression of at least one of a connexin or a gap-junction by the tissue at the stimulation site, whereby the matrix elutes the genetic material to the stimulation site via a porous electrode of the lead. Thus, for similar reasons, the cited references fail to disclose or suggest the method of claim 35, which requires introducing a genetic material to a polymeric matrix and placing the matrix into a chamber formed by a chamber body of a medical lead.

For at least these reasons, the Examiner has failed to establish a *prima facie* case for non-patentability of Appellant's independent claim 35 under 35 U.S.C. § 103(a). Claims 36–42 depend from claim 35 and are patentable over Soykan in view of Heil and Girouard for at least the reasons discussed above with respect to independent claim 35

For the foregoing reasons, reversal of the rejection of claims 21–24, 26, 29–33, 35–42, and 46 under 35 U.S.C. § 103(a) as being unpatentable over Soykan in view of Heil and Girouard is respectfully requested.

CONCLUSION

The Examiner has failed to meet the burden of establishing a *prima facie* case of nonpatentability with respect to Appellant's claims –24, 26, 29–33, 35–42, and 46. Appellant respectfully requests review of the rejections addressed above, and reversal of all pending rejections. Appellant respectfully requests separate review by the Board for each set of claims argued under separate headings for the ground of rejection addressed above.

Date:

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APPENDIX A

THE CLAIMS ON APPEAL

Claim 21: A medical lead comprising:

a lead body;

a porous electrode mounted on a lead body to deliver electrical stimulation to a stimulation site within a patient; and

a chamber body that defines a chamber, the chamber containing a polymeric matrix that absorbs a genetic material and elutes the genetic material to tissue at the stimulation site via the porous electrode, wherein the genetic material is adapted to cause expression of at least one of a connexin or a gap-junction by the tissue at the stimulation site to increase the conductivity of the tissue at the stimulation site.

Claim 22: The medical lead of claim 21, wherein the matrix comprises extracellular collagen.

Claim 23: The medical lead of claim 21, wherein the matrix is cross-linked, and elutes the absorbed genetic material at a rate that is a function of the cross-linking.

Claim 24: The medical lead of claim 21, wherein the chamber body is separable from the lead for loading with the matrix and the genetic material.

Claim 26: The medical lead of claim 21, wherein the genetic material comprises at least one of a viral vector, a liposomal vector or plasmid deoxyribonucleic acid (DNA).

Claim 29: The medical lead of claim 28, wherein the genetic material is adapted to cause expression of connexin-43 by the tissue at the stimulation site.

Claim 30: The medical lead of claim 21, wherein the genetic material is adapted to cause expression of at least one of a metalloproteinase, an anti-inflammatory agent or an immunosuppressant agent.

Claim 31: The medical lead of claim 30, wherein the genetic material is adapted to cause expression of I κ B.

Claim 32: The medical lead of claim 21, wherein the electrode is implantable within the patient.

Claim 33: The medical lead of claim 32, wherein the tissue at the stimulation site comprises cardiac tissue.

Claim 35: A method comprising:
introducing genetic material to a polymeric matrix; and
placing the matrix into a chamber formed by a chamber body of a medical lead for elution of the genetic material to tissue of a patient at a stimulation site, wherein the genetic material is adapted to cause expression of at least one of a connexin or a gap-junction by the tissue at the stimulation site to increase the conductivity of the tissue at the stimulation site, the medical lead including a porous electrode, wherein the matrix elutes the genetic material to the stimulation site via the porous electrode.

Claim 36: The method of claim 35, further comprising:
blending extracellular collagen and gelatin; and
freeze-drying the blended extracellular collagen and gelatin to form the matrix.

Claim 37: The method of claim 35, further comprising:
identifying the genetic material and an elution rate; and
cross-linking the matrix based on the genetic material and the elution rate.

Claim 38: The method of claim 35, further comprising lyophilizing the matrix containing the genetic material.

Claim 39: The method of claim 35, further comprising:
freezing the chamber body containing the matrix and the genetic material; and
providing the frozen chamber body to a clinician,
wherein the clinician thaws the chamber body and assembles the lead to include the
chamber body for implantation of the lead into the patient.

Claim 40: The method of claim 35, further comprising:
soaking the matrix in the genetic material; and
placing the matrix into the chamber.

Claim 41: The method of claim 40,
wherein soaking the matrix in the genetic material and placing the matrix into the
chamber comprises soaking the matrix in the genetic material and placing the matrix into the
chamber by a clinician, and
wherein the lead comprises a lead body, and the clinician assembles the lead body,
chamber body and electrode prior to implantation of the lead within the patient.

Claim 42: The method of claim 35, wherein the chamber body is located at a distal end of
the lead, the method further comprising immersing the distal end of the lead into the genetic
material by a clinician to introduce the genetic material to the matrix.

Claim 46: The medical lead of claim 21, wherein the genetic material is adapted to cause
expression of at least one of a connexin or a gap-junction by the tissue at the stimulation site to
increase the conductivity of the tissue at the stimulation site and create a preferential conduction
pathway between the stimulation site and at least one of a bundle of His or a Purkinje fiber of a
heart of the patient.

APPENDIX B
EVIDENCE

None.

APPENDIX C
RELATED PROCEEDINGS

None.